

**REMARKS**

Claims 1-20 are pending in this application.

Claim 7 has been amended, above.

Claims 1-15 have been rejected under 35 U.S.C. § 101.

Claim 7 has been rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-20 have been rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,389,538 to Gruse et al. (“Gruse”).

Claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,389,538 to Gruse et al. (“Gruse”) in view of U.S. Patent No. 5,832,206 to De Jesus et al. (“De Jesus”).

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

**I. EXAMINER’S COMMENTS REGARDING PREVIOUS ARGUMENTS**

The Examiner has noted that the previous arguments with respect to claims 1-20 have been rendered moot in view of the Examiner’s new ground(s) of rejection. Although not explicitly stated, Applicant considers this an indication that the Examiner has withdrawn the previous rejection(s) of claims 1-20.

If this is not accurate, Applicant respectfully requests that the Examiner explicitly state so.

## II. REJECTION UNDER 35 U.S.C. § 101

The Office Action rejects Claims 1-15 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

Initially, Applicant respectfully draws the Examiner's attention to MPEP § 2106(II)(A) regarding rejections under 35 U.S.C. § 101: "Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed **to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application** in the technological arts **should it be rejected under 35 U.S.C. 101.** (Emphasis added). Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971)."

Claim 1 requires "**A method for controlling access to information**, the method comprising the steps of." (Emphasis added).

Applicant submits that claim 1 is drawn to a method for performing some task or function, which satisfies the statutory requirements of 35 U.S.C. § 101. The invention as claimed in claim 1 produces a useful result – it provides a method through which access to certain information may be controlled. Controlling access to information is useful and has utility.

In the rejection, the Examiner asserts that "Claim 1 states 'maintaining ... a contact list ... utilizing the contact list in conjunction with a revocation list ...,' and then asserts that "These limitations are considered non-statutory subject matter because they consist on [sic] software process steps without any application to a hardware device."

Applicant respectfully objects to and traverses the Examiner's incomplete and misleading recitation of certain limitations in the method of claim 1.

Claim 1 requires "maintaining, **for a given entity** controlling access to the information, a contact list comprising information **identifying one or more other entities** which have attempted to **communicate with the given entity**." (Emphasis added).

Claim 1 also requires "utilizing the contact list in conjunction with a revocation list **associated with the given entity** to determine **which** of at least a subset **of the one or more other entities** are authorized to communicate **with the given entity**." (Emphasis added).

These limitations of claim 1 recite the performance of process steps in relation to structures, and find sufficient support within the specification.

Claim 1 overcomes the rejection under 35 U.S.C. § 101. Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims 2-15 depend from claim 1 and thus overcome the rejection under 35 U.S.C. § 101. Applicant respectfully requests reconsideration and withdrawal of these rejections.

### **III. REJECTION UNDER 35 U.S.C. § 112, ¶2**

The Office Action rejects claim 7 under 35 U.S.C. § 112, second paragraph, as lacking proper antecedent basis for "the modified local revocation list."

Applicant has amended claim 7, above, solely for the purpose of providing a proper antecedent basis for the original claim term.

Applicant submits that claim 7 now overcomes the rejection under 35 U.S.C. § 112, and respectfully requests reconsideration and withdrawal of this rejection.

**IV. REJECTION UNDER 35 U.S.C. § 102(e)**

The Office Action rejects Claims 1-20 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,389,538 to Gruse et al. (“Gruse”). These rejections are respectfully traversed.

**a. Claim 1**

Regarding claim 1, the Examiner claims that Gruse “teaches and describes maintaining, for a given entity controlling access to the information, a contact list comprising information identifying one or more other entities which have attempted to communicate with the given entity (Column 45 lines 17-56); and utilizing the contact list in conjunction with a revocation list associated with the given entity to determine which of at least a subset of the one or more other entities are authorized to communicate with the given entity (Column 45 lines 17-56).”

Applicant respectfully traverses the Examiner’s suggested interpretation of Gruse.

Applicant respectfully notes that the Examiner fails to identify a specific correlation between structures in Gruse and the required elements of claim 1. Applicant contends that this provides an insufficient basis for rejection under § 102.

Applicant finds no indication of which Gruse structure correlates to “a given entity” as contended by the Examiner. Applicant does find that Gruse discloses a certificate revocation list associated with (i.e., maintained by) a Clearinghouse 105. (Col. 45, lines 31-32; Col. 39, lines 40-50). Applicant presumes that the Examiner contends that Clearinghouse 105 correlates to “a given entity.”

However, Applicant finds no disclosure or teaching of maintaining a contact list for the Clearinghouse 105 in Gruse. Applicant finds no disclosure or teaching of such a contact list comprising information identifying one or more other entities that have attempted to communicate with the Clearinghouse 105 in Gruse. Applicant finds no disclosure or teaching of utilizing such a contact list in conjunction with the revocation list maintained by Clearinghouse 105 to determine which of those other entities are authorized to communicate with Clearinghouse 105.

In short, Gruse does not disclose a contact list of the type required by claim 1.

In support of the Examiner’s rejection of claim 1, the Examiner also cites text from the present application. Unsure of the Examiner’s intent or reasoning for this citation, Applicant nonetheless respectfully traverses the Examiner’s interpretation of the present application.

Applicant further respectfully points out that in order for a rejection to be proper under 35 U.S.C. § 102, all the limitations of the present claim must be found within a *single* reference.

The Gruse reference does not anticipate claim 1 under 35 U.S.C. § 102.

Claim 1 overcomes the rejection under 35 U.S.C. § 102. Applicant respectfully requests reconsideration and withdrawal of this rejection.

**b. Claims 2-15**

Claims 2-15 depend from claim 1, and provide further limitations distinguishing over the cited Gruse reference. Claims 2-15 therefore also overcome the rejections under 35 U.S.C. §102.

Applicant respectfully requests reconsideration and withdrawal of these rejections.

**c. Claim 16**

Regarding claim 16, the Examiner claims that Gruse “teaches and describes a processor-based device for controlling access to information, wherein the processor-based device is operative to maintain a contact list comprising information identifying one or more other entities which have attempted to communicate with the processor-based device (Column 45 lines 17-56); and to utilize the contact list in conjunction with a revocation list associated with the given entity to determine which of at least a subset of the one or more other entities are authorized to communicate with the given entity (Column 45 lines 17-56).”

Applicant respectfully traverses the Examiner’s suggested interpretation of Gruse.

Applicant again respectfully notes that the Examiner fails to identify a specific correlation between structures in Gruse and the required elements of claim 16. Applicant contends that this provides an insufficient basis for rejection under § 102.

Applicant finds no indication of which Gruse structure correlates to “a processor-based device” as contended by the Examiner. Applicant does find that Gruse discloses a certificate revocation list associated with (i.e., maintained by) a Clearinghouse 105. (Col. 45, lines 31-32; Col. 39, lines 40-50). Applicant presumes that the Examiner contends that Clearinghouse 105 correlates to “a processor-based device.”

However, Applicant finds no disclosure or teaching of maintaining a contact list for the Clearinghouse 105 in Gruse. Applicant finds no disclosure or teaching of such a contact list comprising information identifying one or more other entities that have attempted to communicate with the Clearinghouse 105 in Gruse. Applicant finds no disclosure or teaching of utilizing such a contact list in conjunction with the revocation list maintained by Clearinghouse 105 to determine which of those other entities are authorized to communicate with Clearinghouse 105.

In support of the Examiner's rejection of claim 16, the Examiner also cites text from the present application. Unsure of the Examiner's intent or reasoning for this citation, Applicant nonetheless respectfully traverses the Examiner's interpretation of the present application.

Applicant further respectfully points out that in order for a rejection to be proper under 35 U.S.C. § 102, all the limitations of the present claim must be found within a *single* reference.

The Gruse reference does not anticipate claim 16 under 35 U.S.C. § 102.

Claim 16 overcomes the rejection under 35 U.S.C. § 102. Applicant respectfully requests reconsideration and withdrawal of this rejection.

**d. Claim 17**

Regarding claim 17, the Examiner claims that Gruse "teaches and describes maintaining, for a given entity controlling access to the information, a contact list comprising information identifying one or more other entities which have attempted to communicate with the given entity (Column 45 lines 17-56); and utilizing the contact list in conjunction with a revocation list associated with the given entity to determine which of at least a subset of the one or more other

entities are authorized to communicate with the given entity (Column 45 lines 17-56).”

Applicant respectfully traverses the Examiner’s suggested interpretation of Gruse.

Applicant again respectfully notes that the Examiner fails to identify a specific correlation between structures in Gruse and the required elements of claim 17. Applicant contends that this provides an insufficient basis for rejection under § 102.

Applicant respectfully points out that claim 17 requires an “*article of manufacture comprising a machine-readable storage medium containing one or more software programs for use in controlling access to information.*” Claim 17 further requires that “*the programs when executed implement the steps of: maintaining, for a given entity controlling access to the information, a contact list comprising information identifying one or more other entities which have attempted to communicate with the given entity; and utilizing the contact list in conjunction with a revocation list associated with the given entity to determine which of at least a subset of the one or more other entities are authorized to communicate with the given entity.*”

Applicant finds no indication of which Gruse structure that the Examiner correlates to “*an article of manufacture comprising a machine-readable storage medium containing one or more software programs for use in controlling access to information.*” Applicant does find that Gruse discloses a certificate revocation list associated with (i.e., maintained by) a Clearinghouse 105. (Col. 45, lines 31-32; Col. 39, lines 40-50). Applicant presumes that the Examiner contends that Clearinghouse 105 correlates either to the claimed article of manufacture or to the one or more software programs.

However, Applicant finds no disclosure or teaching of maintaining a contact list for or by the Clearinghouse 105 in Gruse. Applicant finds no disclosure or teaching of such a contact list comprising information identifying one or more other entities that have attempted to communicate with the Clearinghouse 105 in Gruse. Applicant finds no disclosure or teaching of utilizing such a contact list in conjunction with the revocation list maintained by Clearinghouse 105 to determine which of those other entities are authorized to communicate with Clearinghouse 105.

In support of the Examiner's rejection of claim 17, the Examiner also cites text from the present application. Unsure of the Examiner's intent or reasoning for this citation, Applicant nonetheless respectfully traverses the Examiner's interpretation of the present application.

Applicant further respectfully points out that in order for a rejection to be proper under 35 U.S.C. § 102, all the limitations of the present claim must be found within a *single* reference.

The Gruse reference does not anticipate claim 17 under 35 U.S.C. § 102.

Claim 17 overcomes the rejection under 35 U.S.C. § 102. Applicant respectfully requests reconsideration and withdrawal of this rejection.

**e. Claims 18-20**

Claims 18-20 depend from claim 17, and provide further limitations distinguishing over the cited Gruse reference. Claims 18-20 therefore also overcome the rejections under 35 U.S.C. § 102.

Applicant respectfully requests reconsideration and withdrawal of these rejections.

**V. REJECTION UNDER 35 U.S.C. § 103**

The Office Action rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,389,538 to Gruse et al. (“Gruse”) in view of U.S. Patent No. 5,832,206 to De Jesus et al. (“De Jesus”). This rejection is respectfully traversed.

Applicant respectfully submits that the Examiner has improperly rejected this claim with a highly speculative and highly selective hindsight combination of the cited references – a combination not prospectively taught or suggested to one of ordinary skill in the art at the time the present invention was made.

Claim 11 requires, *inter alia*, an updating of the contact list by a random or pseudo-random selection of a particular entry of the contact list for removal from the contact list if there is not sufficient space available in the contact list for a new entity.

The Examiner concedes that Gruse “does not explicitly describe the selecting step is implemented using a random or pseudo-random selection process.”

Applicant agrees.

Applicant submits that Gruse has no reason to “explicitly describe the selecting step is implemented using a random or pseudo-random selection process.” As previously explained, Applicant finds no disclosure or teaching of maintaining a contact list – for which such a selection step would be utilized - in Gruse.

The Examiner then suggests that De Jesus “discloses a method to provide security for a keypad processor of a transaction terminal wherein the selecting step is implemented using a random selection process.”

Applicant respectfully traverses with the Examiner's suggested interpretation of De Jesus.

Applicant finds that De Jesus discloses a multiple-step random process for selecting and generating a signal to confuse an electronic eavesdropper (Col. 10, lines 50-58). De Jesus discloses a random column selection (Col. 8, lines 52-56; Col. 10, lines 46-47), followed by a random row selection (Col. 10, lines 48-49). A random determination is made to whether the randomly selected row is to have a signal provided thereon to confuse an electronic eavesdropper. If the randomly selected row is to be used, a random number T is selected and signals are provided by signal generator 15 of the false polling circuit 16 on both the randomly selected column and row for the duration indicated by random number T. If the randomly selected row is not to have a signal transmitted thereon, then a random number U is selected and a signal is only provided on the conductor of the randomly selected column for the duration indicated by random number U. (Col. 10, lines 50-63).

The Examiner claims that it would have been "obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Gruse and De Jesus, a method for controlling access to information including the step of selecting a particular entry of the contact list for removal as taught by Gruse and the selecting step to be implemented using a random selection process as taught by De Jesus to insure that an electronic eavesdropper will be unable to differentiate the actual selection algorithm" since motivation "to combine the invention of De Jesus with Gruse comes from the need for providing a [sic] access control system to implement a random selection process to provide a normalized deletion rather than criteria based thereby

minimizing computation time.”

Applicant respectfully traverses these assertions.

Applicant respectfully submits that, in order to selectively and speculatively combine the Gruse and De Jesus references as the Examiner has suggested - at the time the present invention was made, having only the cited references before him, *without benefit of the present disclosure* – one of ordinary skill in the art would have to: 1) Evaluate the Gruse reference, finding no disclosure of the existence, maintenance or operation of a contact list that is associated with a given entity that controls access to information, and comprises information identifying one or more other entities which have attempted to communicate with the given entity; 2) spontaneously decide that the disclosure of Gruse was insufficient for its intended purposes; 3) spontaneously decide that the Gruse system needed a contact list that is associated with a given entity that controls access to information, and comprises information identifying one or more other entities which have attempted to communicate with the given entity; 4) successfully integrate such a contact list into the Gruse system and modify the operation of the Gruse system such that the contact list could be utilized in conjunction with Gruse’s already-existing revocation list to determine which other entities are authorized to communicate with the given entity; 5) spontaneously decide that the now integrated contact list implemented in the Gruse system may have limited capacity and therefore need to remove entries from the list to be replaced with new entries; 6) spontaneously decide that such removal would need to provide normalized deletion rather than criteria based deletion; 7) spontaneously determine that a random selection process would best address such a need; 8) seek out and find the De Jesus reference –

describing an invention directed toward providing secure transaction terminals and preventing the fraudulent acquisition of information, such as personal identification numbers (PINs), entered through the keypad – as a source of a suitable random selection process; 9) selectively cull from De Jesus only a multiple-step random process for selecting and generating a signal to confuse an electronic eavesdropper, disregarding all of De Jesus' other structures and operations; and 11) successfully modify the structures and operations of the already modified Gruse system to now incorporate random selection of contact list removals.

Applicant respectfully submits that there is no teaching or suggestion in either Gruse or De Jesus sufficient to motivate one of ordinary skill to undertake such a highly speculative and selective combination of two references. Even if such a complicated combination effort were successful, the result would still not yield the required limitations of claim 11. Neither reference teaches or suggests a pseudo-random process.

Even though the Examiner does not cite it as a basis for the § 103 rejection, the Examiner nonetheless again provides an interpretation of a portion of the present application. Applicant respectfully traverses the Examiner's suggested interpretation of the present application. Applicant respectfully notes that the cited portion of the present application does not disclose or suggest random or pseudo-random selection of list entries for removal.

Claim 11 depends from allowable claim 1 and provides further limitations distinguishing over the cited references.

Claim 11 overcomes the § 103 rejection. Applicant respectfully requests reconsideration and withdrawal of this rejection.

V. **CONCLUSION**

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

**SUMMARY**

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at [wmunck@davismunck.com](mailto:wmunck@davismunck.com).

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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